

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

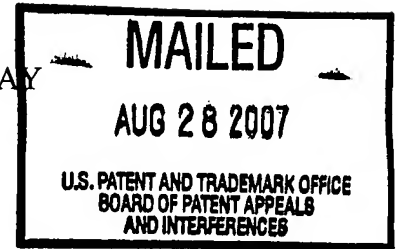
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Ex parte : RUSSELL MUMPER and MICHAEL JAY

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Application No. 10/072,320

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on August 22, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

**INFORMATION DISCLOSURE STATEMENT**

Appellant filed Information Disclosure Statement's (IDSs) dated June 26, 2006, December 8, 2006 and February 27, 2007. There is no indication in the record that the above identified Information Disclosure Statement's have been considered by the Examiner. MPEP 609 requires the Examiner to consider any Information Disclosure Statement filed by Applicant if timely submitted. A written communication notifying appellant of the Examiner's consideration of the above Information Disclosure Statement is required.

**APPEAL BRIEF**

**Summary Of Claimed Subject Matter**

Appellant filed an Appeal Brief dated June 22, 2005, in response to the Final Rejection mailed November 17, 2004. The Appeal Brief is not in compliance with the new rules of 37 CFR § 41.37(c) effective September 13, 2004.

37 CFR § 41.37(c) states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

\* \* \*

(c)(1) The brief shall contain the following items...of this section:

(v) ***Summary Of Claimed Subject Matter***. A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief . The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

Section 37 CFR § 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).

### **EXAMINER'S ANSWER**

#### **GROUND OF REJECTION**

The record reflects that on November 17, 2004, a Final Rejection was mailed which included a rejection to Claims 33-47, "52" and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckenhoff over Biegajski (pg.4). On October 20, 2005, an Examiner's Answer was mailed which indicated that Claims 33-47, "51" and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckenhoff over Biegajski (pg. 4).

Clarification of claims being rejected under 35 U.S.C. 103(a) is required.

If or when a new ground of rejection is introduced in the Examiner's Answer, the Examiner is required to obtain approval of the Technology Center Director or his/her designee. Further, any new ground of rejection is required to be prominently identified, eg., a separate heading with all capitalized letters. See MPEP § 1207.02(A)(6)(d).

**ORDER RETURNING UNDOCKETED APPEAL**

**EXAMINER'S CONSIDERATION OF REPLY BRIEF**

On February 14, 2006, the Board of Patent Appeals mailed an Order Returning Undocketed Appeal (hereinafter "Order"), advising the Examiner that there was no indication in the record that the Reply Brief filed December 27, 2005, had been considered or acknowledged. The Order required the Examiner to consider and acknowledge the Reply Brief. A further review of the record reveals that the Reply Brief filed December 27, 2005, still has not been considered or acknowledged.

Under 37 CFR 41.41, appellant may file a reply brief as a matter of right....

The primary examiner must then either: (A) acknowledge receipt and entry of the reply brief... or (B) reopen prosecution to respond to the reply brief.

Consideration and acknowledgment of the Reply Brief is required.

**CONCLUSION**

Accordingly, it is

**ORDERED** that the application is returned to the examiner for:

- 1) issue and mail a PTOL-90 giving consideration and proper written response to the identified Information Disclosure Statement's dated June 26, 2006, December 8, 2006 and February 27, 2007;
- 2) to notify appellants of such consideration;
- 3) hold the Appeal Brief filed June 22, 2005, defective;

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4) notify the Appellant to submit a "paper" which corrects the Appeal Brief, Summary of Claimed Subject Matter ;


5) issue and mail a PTOL-90, to:

a) clarifying the above identified 103(a) rejection (see Examiner's Answer, Ground of Rejection, pg. 3 above);

b) acknowledge and considered any "paper" filed by appellant correcting the Appeal Brief, Summary of Claimed Subject Matter; and

c) consider and acknowledge the Reply Brief filed December 27, 2005.

BOARD OF PATENT APPEALS  
AND INTERFERENCES



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PATRICK J. NOLAN  
DEPUTY CHIEF APPEALS ADMINISTRATOR  
(571) 272-9797

PJN/dpv

David L. Parker, Esq.  
Fulbright & Jaworski, LLP  
Suite 2400  
600 Congress Ave.  
Austin, TX 78701